



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/575,689

05/21/2007

Colette Colladant

120164.417USPC

3581

500

7590

07/02/2010

SEED INTELLECTUAL PROPERTY LAW GROUP PLLC

701 FIFTH AVE

SUITE 5400

SEATTLE, WA 98104

EXAMINER

BADIO, BARBARA P

ART UNIT

PAPER NUMBER

1628

MAIL DATE

DELIVERY MODE

07/02/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/575,689	<b>Applicant(s)</b> COLLADANT ET AL.	
	<b>Examiner</b> Barbara P. Badio	<b>Art Unit</b> 1628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 3-6,8 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,7,9 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/21/2007</u> .   | 6) <input type="checkbox"/> Other: ____.                          |

**First Office Action on the Merits**

***Election/Restrictions***

1. Applicant's election without traverse of Group I, claims 1, 2 and 7 in the reply filed on June 18, 2010 is acknowledged.
2. Based on applicant's election of Group I, claims 9 and 10 will be examined to the extent they read on medication or composition comprising the compound of Group I. Therefore, claims 3-6 and 11 stand withdrawn from further consideration as being drawn to a nonelected invention.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1, 2, 7, 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The instant claims are indefinite for the following reasons:

- (a) Claims 1 and 2 lack a period at the end; and
- (b) Claims 7 and 10 recite the phrase "particularly in" and "possibly in", respectively. The above-mentioned phrases render the claims indefinite because it is

Art Unit: 1628

unclear whether the limitation following each phrase is part of the claimed invention.

See MPEP § 2173.05(d).

For these reasons, the skilled artisan would be unable to determine the metes and bound of the claimed invention.

### ***Double Patenting***

5. Claim 2 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Note: Both claims are drawn to “crystalline form A of 3 $\beta$ -amino-17-methylene-androstane-6 $\alpha$ ,7 $\beta$ -diol hydrochloride”. The property recited by claim 2 is inherently present in the compound of claim 1 and vice versa.

### ***Claim Rejections - 35 USC § 102***

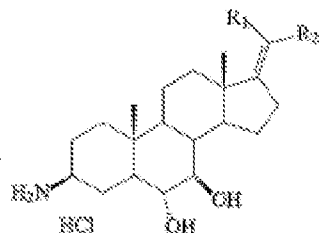
6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

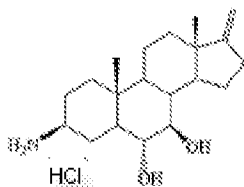
7. Claims 1, 2, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Raymond et al. (WO 01/83512 cited on IDS submitted by applicant on 5/21/2007).

Raymond et al. teaches salts of 3 $\beta$ -amino-6,7-dihydroxy-17-methylidene steroids  
oxygen steroids of formula:



wherein R<sub>2</sub> is hydrogen and R<sub>1</sub> is hydrogen, methyl, ethyl, propyl, butyl or pentyl (see the entire article, especially Abstract, page 30, Scheme E; claims 11, 12; page 63, Synthesis of Compound 28; page 22, lines 26-32; ).

The court has held that a prior art directed to a recognizable small class of compounds, having common properties which embrace the claimed compound, herein,



, is anticipatory notwithstanding the fact the claimed compound is not specifically named. *In re Schaumann et al.* (CCPA 1978) 572 F2d 312, 197 USPQ 5; *In re Petering et al.* (CCPA 1962) 301 F2d 676, 133 USPQ 275.

The recitation of X-ray diffraction pattern or unit cell parameters at 295 K is noted. However, the recitation of unknown property that is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

***Telephone Inquiry***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio whose telephone number is 571-272-0609. The examiner can normally be reached on M-F from 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Barbara P. Badio/  
Primary Examiner, Art Unit 1628